



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,965	09/08/2006	Karlfried Pfeifenbring	PR-88	8652
20311 7590 06/03/2011 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER LAVILLA, MICHAEL E				
ART UNIT		PAPER NUMBER		
1784				
NOTIFICATION DATE		DELIVERY MODE		
06/03/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmiplaw.com

### Office Action Summary

**Application No.**

10/539,965

**Applicant(s)**

PFEIFENBRING ET AL.

**Examiner**

MICHAEL LA VILLA

**Art Unit**

1784

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2011.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-8, 10-12 and 14-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 1-8, 10 and 14-16 is/are allowed.  
6) ☒ Claim(s) 11 and 12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 17 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**WITHDRAWAL OF FINALITY**

1. The FINALITY of the FINAL REJECTION mailed on 20 January 2011 has been WITHDRAWN. Applicant's amendment filed on 20 May 2011 has been ENTERED.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the fourth paragraph of 35 U.S.C. 112:
3. Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.
4. Claims 11 and 12 are rejected under 35 U.S.C. 112, fourth paragraph.
5. Previous Claim 5 specifies that the tubes are copper tubes. The Specification teaches that copper tubes are not copper-nickel tubes. See Specification at page 11, line 3, for example. Since copper-nickel tubes are not copper tubes, these dependent claims cannot be said to be properly further limiting of previous Claim 5. The claim scope would be considered to outside that encompassed by previous Claim 5.
6. The following is a quotation of the first paragraph of 35 U.S.C. 112:
7. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
8. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding Claim 11, the claim requires a copper-nickel tube that is coated with nickel electroplating layer. However, the Specification teaches that the copper-nickel tubes having the breadth of the claimed relative amounts of copper and nickel are to have a copper electroplating layer, not nickel layers. See Specification at page 11, line 1-6. While there is an example of a specific copper nickel alloy tube that is coated with nickel, this example is disparaged, and there is no basis for concluding that the Specification reasonably conveys that applicant possessed the breadth of copper-nickel tubes as claimed in Claim 11 being nickel coated as claimed.

***Allowable Subject Matter***

9. Claims 5-8, 10, and 14-16 are allowed.

***Response to Amendment***

10. In view of applicant's amendments and arguments, the section 112, second paragraph rejection and the section 102/103 rejection over McRae of the Office Action mailed on 20 January 2011 are overcome and therefore withdrawn.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL LA VILLA whose telephone number is (571)272-1539. The examiner can normally be reached on Monday through Friday.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil, can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/MICHAEL LA VILLA/  
MICHAEL LA VILLA  
Primary Patent Examiner, Art Unit 1784  
31 May 2011**